

11-26-2001

U.S. Patent & TMC's/TM Mail Rpt Dt. #22

TAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

In re: LABCAST
Application Serial No.: 75/813380
Current Applicant: Varian, Inc. (Prior Applicant: VanKel
Technology Group)

Opposition No. 91150161

Innovative Programming Associates, Inc.

Opposer

v.

Varian, Inc.

Applicant

ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM
TO RESTRICT OPPOSER'S REGISTRATION

11/30/2001 K513300S 00000023 75/813380

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ANSWER

Application Serial No. 75/813380 was original filed by VanKel Technology Group. In September, 2000, VanKel Technology Group, Inc. merged with and into Varian, Inc., a corporation organized and existing under the laws of the State of Delaware, with a business address at 3120 Hansen Way, Palo Alto, CA 94304. Varian, Inc. is the present owner of Application Serial No. 75/813380 as reflected in the Recordation Section of the U.S. Trademark Office, Reel/Frame No. 002349/0063, recorded on July 31, 2001, prior to the commencement of this opposition proceeding. All references in the Answer to "Applicant" shall refer to "Varian, Inc."

WKS

Applicant further requests that the caption be corrected accordingly as appears above.

1. Applicant is without sufficient information to admit or deny the allegations of Paragraph 1 of the Notice, and on this ground denies the same, although Applicant admits that an Exhibit A was attached to the Notice.

2. Applicant admits the allegations of Paragraph 2 of the Notice.

3. Applicant admits the allegations of Paragraph 3 of the Notice.

4. Applicant is without sufficient information to admit or deny the allegations of Paragraph 1 of the Notice, and on this ground denies the same.

5. Applicant denies the allegations of Paragraph 5 of the Notice.

6. Applicant denies that Opposer had any "prior" rights vis-à-vis Applicant's rights in its mark or that the term "[N]otwithstanding" is appropriately used in light of the lack of merit in Opposer's claims, but Applicant admits the remaining allegations of Paragraph 6 of the Notice.

7. Applicant admits the allegations of Paragraph 7 of the Notice.

8. Applicant denies the allegations of Paragraph 8 of the Complaint.

9. The terms "covered" and "include" as used in Paragraph 9 are vague and ambiguous, and Applicant

accordingly denies the allegations of Paragraph 9 of the Notice.

10. Applicant admits that Opposer is not connected in any way with the services offered by Applicant, and Applicant denies that Applicant requires Opposer's consent or permission to use Applicant's mark for Applicant's services.

11. Applicant is without sufficient information to admit or deny the allegations of Paragraph 11, and furthermore the terms "covered" and "include" are vague and ambiguous, and on these bases, Applicant denies the allegations of Paragraph 11 of the Notice.

12. Applicant denies the allegations of Paragraph 12 of the Notice.

13. Applicant denies the allegations of Paragraph 13 of the Notice.

14. Applicant admits that registration of Applicant's mark on the Principal Register would presumptively give to the Applicant prima facie exclusive ownership of its mark as used with those services enumerated in the registration, and Applicant denies the remaining allegations of the Notice.

15. Applicant denies the allegations of Paragraph 15 of the Notice.

16. Applicant denies the allegations of Paragraph 16 of the Notice.

AFFIRMATIVE DEFENSES

1. There is no likelihood of confusion between Applicant's mark as used on the services listed in its application and Opposer's alleged mark in Opposer's registration.

COUNTERCLAIM FOR RESTRICTIONS ON OPPOSER'S REGISTRATION

NO. 1284179 FOR THE MARK LABCAT

1. Applicant and Cross-Petitioner Varian, Inc. (hereinafter still referred to as "Applicant" for consistency) is an international corporation headquartered in Palo Alto, California principally engaged in diverse aspects of the life sciences industries.

2. Applicant is the owner of Application Serial No. 75/813380 for the mark LABCAST for "video broadcasting services, namely providing video broadcasting to selected customers in a video conference setting demonstrating use of analytical laboratory equipment." Opposer seeks to prevent Applicant's application from issuing as a registration on the Principal Register on the basis of Opposer's Reg. No. 1284179 for the mark LABCAT registered for "computer programs recorded on magnetic discs" in Class 09.

3. Opposer is using its registration to deprive Applicant of the benefits of the registration on the Principal Register to which it is entitled, thus Opposer has standing to assert this counterclaim against Opposer and Reg. No. 1284179.

4. Applicant asserts this counterclaim for modification or restriction of Opposer's registration pursuant to 15 U.S.C.

Section 1068 (Section 18 of the Lanham Act).

5. Applicant alleges that Opposer's overly broad description of goods does not do equity and does not fairly or accurately reflect the true and much more restricted nature and function of Opposer's goods as is required for applications pursuant to T.M.E.P. Section 804.03(b). As noted therein:

Any identification of goods for computer programs or comparable goods must specify the purpose or function of the program. The Office will no longer accept identifications which merely identify the intended users, the field of use or the industry in which the program is used.

6. Under this standard and the Board's recent interpretations of Section 18 of the Lanham Act as exemplified by *Milliken & Company v. Image Industries, Inc.*, 39 USPQ2d 1192 (TTAB 1996), by modifying and/or restricting the goods in Opposer's registration by providing the "function" of Opposer's computer programs, it will be even clearer than now appears that there is no likelihood of confusion between Opposer's mark used on Opposer's goods and Applicant's mark as used with Applicant's services.

7. Applicant further alleges that Opposer is not using its LABCAT mark on the goods that will be effectively excluded by the proposed restriction requiring Opposer to include in its identification of goods the function of Opposer's computer programs.

8. Based on the marketing piece submitted as an exhibit

with Opposer's Notice of Opposition, Applicant proposes that the Board amend Opposer's Registration No. 1284179 to the following more accurate and more specific identification: "integrated computer software modules for the collection, analysis, and reporting of data during the pre-clinical phases of pharmaceutical, agrochemical, and biotech product development." Once the Board implements this restriction on Opposer's goods by an amendment pursuant to Section 18 of the Lanham Act, it will be clear that Opposer's claims of a likelihood of confusion are frivolous, and should be dismissed.

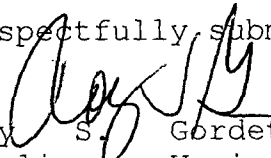
WHEREFORE, this Notice of Opposition should be dismissed with prejudice, and Applicant's registration should issue forthwith in the name of Varian, Inc.

The official filing fee of \$300 for the counterclaim is submitted herewith. Please direct all correspondence to the undersigned attorney for Applicant, who is a member of the Bars of New York and California, at the following address:

Roy S. Gordet
Attorney at Law
530 Bush Street, Suite 601
San Francisco, CA 94108
Tel. 415-255-1165
Fax 415-255-1165

Please refer to our Docket No. 156-13.

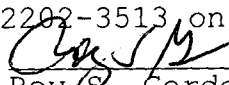
Respectfully submitted,


Roy S. Gordet, Attorney for
Applicant, Varian, Inc.

Roy S. Gordet
Attorney at Law
530 Bush Street, Suite 601
San Francisco, CA 94108
Tel. 415-255-1165

CERTIFICATE OF EXPRESS MAILING ET 243153636 US

I certify that this document is being deposited with the United States Postal Service, Express Mail, postage pre-paid, addressed to Commissioner of Trademarks, Attn: TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513 on November 26, 2001.
Dated: *Nov 26, 2001*


Roy S. Gordet

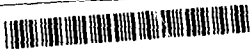
CERTIFICATE OF SERVICE

I certify that I served a copy of this document and the Transmittal Letter on Opposer by mailing it with the United States Postal Service, First Class postage pre-paid, addressed as follows:

Charles F. Manero, Woodbridge & Associates, P.O. Box 592, Princeton, NJ 08542-0592 on November 26, 2001.

Dated: *Nov 26, 2001*


Roy S. Gordet



11-26-2001

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R O Y S G O R D E T

Attorney at Law

530 BUSH STREET . SUITE 601 . SAN FRANCISCO . CA 94108
TEL 415.255.1165 . FAX 415.255.0343

TRANSMITTAL LETTER

By U.S. Express Mail Overnight Delivery
November 26, 2001

Assistant Commissioner for Trademarks
Attn. TTAB
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Opposition No. 91150161 Against Application
Serial No. 75813380 for the Mark LABCAST

Dear Madam:

Enclosed please find the following:

- 1) Answer To Notice of Opposition with Counterclaim
to Restrict Opposer's Registration
- 2) Check No. 14635 in the amount of \$300 for the Counterclaim
- 3) A self-addressed postcard to acknowledge receipt

Please endorse the self-addressed postcard and return it to the undersigned attorney for Applicant/Respondent and Cross-Petitioner. As noted in the accompanying Answer with Counterclaim, all correspondence in this matter should be directed to the undersigned attorney for Applicant. Please reference our Docket No. 156-13.

Your attention to this matter will be appreciated.

Sincerely,



Roy S. Gordet

RSG/ms

Enclosures

cc: Hunter L. Auyang, Esq.

Charles F. Manero, Esq. (counsel for Opposer)